REMARKS/ARGUMENTS

Claims 1-14 are pending in the present application. No claims were canceled or amended; and claim 15 was added. Support for the addition of claim 15 may be found in the Specification at least on pages 13 though 14 and in Figure 4A. No new material has been added by the addition of Claim 15. Reconsideration of the claims is respectfully requested.

I. 35 U.S.C. § 101 (Claim 14)

The Examiner has rejected claim 14 under 35 U.S.C. § 101 as being directed towards non-statutory subject matter. This rejection is respectfully traversed.

The Office Action rejects claim 14 as being directed towards non-statutory subject matter because claim 14 is "lacking of real world useful result." (See Office Action mailed March 9, 2007, p. 2) Applicants respectfully disagree. Claim 14 recites the feature of ***fourth instructions for returning the search results, wherein the search results include a list of universal resource identifiers associated with the Web pages within the Web site.*** Applicants respectfully submit that **returning** a **list of universal resource identifiers** associated with the Web pages within the Web site to requestor qualifies as a "real world useful result."

Furthermore, the Office Action rejects claim 14 as being directed towards non-statutory subject matter because the Office Action asserts that claim 14 is not limited to a tangible embodiment. No basis is present for holding a computer usable medium claim non-statutory because the medium may be allegedly "intangible." The MPEP states:

> In this context, "functional descriptive material" consists of **data structures** and computer programs **which impart functionality when employed as a computer component**. (The definition of "data structure" is "a physical or logical relationship among data elements, designed to support specific data manipulation functions." The New IEEE Standard Dictionary of Electrical and Electronics Terms 308 (5th ed. 1993).) "Nonfunctional descriptive material" includes but is not limited to music, literary works and a compilation or mere arrangement of data.
>
> **When functional descriptive material is recorded on some computer-readable medium it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized**. Compare *In re Lowry*, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994) (claim to data structure stored on a computer readable medium that increases computer efficiency held statutory) and *Warmerdam*, 33 F.3d at 1360-61, 31 USPQ2d at 1759 (claim to computer having a specific data structure stored in memory held statutory product-by-process claim) with *Warmerdam*, 33 F.3d at 1361, 31 USPQ2d at 1760 (claim to a data structure *per se* held nonstatutory).

MPEP 2106 (IV)(B)(1) (**emphasis added**)

Claim 14 recites clearly functional descriptive material since it imparts functionality when employed as a computer component. Moreover, the functional descriptive material of claim 14 is recorded on "some" computer-readable medium.

In the above context, the term "some" means "any" computer-readable medium. The MPEP does not draw any distinctions between one type of media that is considered to be statutory and another type of media that is considered to be non-statutory. To the contrary, the MPEP clearly states that as long as the functional descriptive material is in "some" computer-readable medium, it should be considered statutory. The only exceptions to this statement in the MPEP are functional descriptive material that does not generate a useful, concrete and tangible result, e.g., functional descriptive material composed completely of pure mathematical concepts that provide no practical result. Claim 14 clearly recites a useful, concrete and tangible result in that search results, which include a list of universal resource identifiers associated with Web pages within a Web site, are returned to a requestor, which is provided to the requestor so that these search results may be accessed. This is not just some disembodied mathematical concept or abstract idea.

Thus, claim 14 is directed to functional descriptive material that provides a useful, concrete and tangible result, and which is embodied on "some" computer-readable medium. Therefore, claim 14 is statutory and the rejection of the claim 14 under 35 U.S.C. § 101 has been overcome.

Therefore, Applicants request that the rejection of the claim 14 under 35 U.S.C. § 101 be withdrawn.

II. 35 U.S.C. § 102, Anticipation (Claims 1-14)

The Office Action rejects claims 1-14 under 35 U.S.C. § 102 as being anticipated by *Schneider*, Fictitious Domain Name Method, Product, and Apparatus, U.S. Patent No. 7,136,932, November 14, 2006 (hereinafter "*Schneider*"). This rejection is respectfully traversed.

The Office Action states:

> With respect to claim 1, Schneider teaches a method in a data processing system for searching for Web pages within a Web site (a system for searching web pages from one of search engines to locate web pages or hits within a Web site from clients (item 1 10): see fig. 1a and 1b, and col. 17, lines 34-44; also col. 10, lines 58-67), the method comprising:
>
> receiving a search statement as a result of a user input, wherein the search statement includes a universal resource identifier and a regular expression (receiving the input search request or search or query string including URI or string of characters for identifying an abstract or physical resource from the client of the system: see fig. 2a, col. 4, lines 30-56 and col. 18, lines 30-56);
>
> retrieving universal resource identifiers associated with the universal resource identifier in the request to form retrieved universal resource identifiers

(retrieving from a database to generate valid URIs based on the search string: fig. 16 and col. 34, lines 18-32);

parsing the retrieved universal resource identifiers for the regular expression to form search results (parsing retrieved URIs via a parsing schema: see fig. 2b, item 260 and 2a, item 210: col. 21, lines 48-63; also col. 30, lines 30-42 and col. 18, lines 30-55); and

returning the search results, wherein the search results include a list of universal resource identifiers associated with the Web pages within the Web site (the result of the search is displayed (item 222 in fig. 2a) and as a list of valid URIs (fig. 13): col. 30, lines 22-30 and col. 18, lines 40-55).

Office Action dated March 9, 2007, pp.5-6.

With respect to this rejection, a prior art reference anticipates the claimed invention under 35 U.S.C. § 102 only if every element of a claimed invention is identically shown in that single reference, arranged as they are in the claims. *In re Bond*, 910 F.2d 831, 832, 15 U.S.P.Q.2d 1566, 1567 (Fed. Cir. 1990). All limitations of the claimed invention must be considered when determining patentability. In re Lowry, 32 F.3d 1579, 1582, 32 U.S.P.Q.2d 1031, 1034 (Fed. Cir. 1994). Anticipation focuses on whether a claim reads on the product or process a prior art reference discloses, not on what the reference broadly teaches. Kalman v. Kimberly-Clark Corp., 713 F.2d 760, 218, U.S.P.Q. 781 (Fed. Cir. 1983). In this particular case, each and every feature of the presently claimed invention is not identically shown or described in *Schneider*, arranged as they are in the claims.

For example, claim 1 recites the following:

1. A method in a data processing system for searching for Web pages within a Web site, the method comprising:

receiving a search statement as a result of a user input, wherein the search statement includes a universal resource identifier and a regular expression;

retrieving universal resource identifiers associated with the universal resource identifier in the request to form retrieved universal resource identifiers;

parsing the retrieved universal resource identifiers for the regular expression to form search results; and

returning the search results, wherein the search results include a list of universal resource identifiers associated with the Web pages within the Web site.

The Office Action alleges that *Schneider* teaches all the features of claim 1. Applicants respectfully disagree. For example, *Schneider* fails to teach the feature of ***receiving a search statement as a result of a user input, wherein the search statement includes a universal resource identifier and a regular expression.*** The Office Action points to column 4, lines 30 through 56 and column 18, lines 29 through 56, reproduced below for the Examiner's convenience, as teaching this feature.

A Uniform Resource Identifier (URI) is a compact string of characters for identifying an abstract or physical resource. URIs are the generic set of all

names and addresses that refer to objects on the Internet. URIs that refer to objects accessed with existing protocols are known as Uniform Resource Locators (URLs). A URL is the address of a file accessible on the Internet. The URL contains the name of the protocol required to access the resource, a domain name or IP address that identifies a specific computer on the Internet, and a hierarchical description of a file location on the computer. In addition, the last (optional) part of the URL may be a "query string" preceded by "?" or a "fragment identifier" preceded by "#". The fragment identifier indicates a particular position within the specified file. For example the URL "http://www.example.com:80/index.html#appendix", where "http" is the scheme or protocol, "www.example.com" is the host server name or Fully Qualified Domain Name (FQDN), "80" is the port connection for the HTTP server request, "index.html" is the filename located on the server, and "appendix" is the identifier to display a specific portion of the HTML file called "index". The URL "http://www.example.com" also retrieves an HTML file called "index" on the HTTP server called "example.com". By default, when either a port or filename is omitted upon accessing a HTTP server via a URL, the client browser interprets the request by connecting via port **80**, and retrieving the HTML file called "index".

FIG. **2**a is a top-level flowchart illustrating the steps of an exemplary prior art system for requesting a network resource from an identifier by using resource location and/or name resolution services. A network access apparatus **110**, servlet, applet, stand-alone executable program, command line of a device such as a phone browser, or user interface element such as a text box object or location field **154** of a web browser **112**, can receive and parse input such as text in step **210**. The input **210** can then be updated in step **212** into a history database. Tests can also be performed to determine how to process the received input **210**. For instance, when it is determined in step **214** that the input **210** has no "." delimiters or " " delimiters only, it becomes clear that there is no domain name or IP address present and the input **210** can be processed as a search request in step **218**. Results if any, can then be notified, accessed, and/or displayed in step **222**. When the presence of the "." delimiter is determined in step **214**, the input **210** may include either an IP address or a domain name. When a domain name is parsed in step **210**, the validity of the domain name is determined in step **226**. Validity of URI syntax is provided in T. Berners-Lee, "Informational RFC (Request for Comment) 1630: Universal Resource Identifiers in WWW--A Unifying Syntax for the Expression of Names and Addresses of Objects on the Network as used in the World-Wide Web", Internet Engineering Task Force (IETF), June 1994, "http://www.faqs.org/rfcs/rfc1630.html", which is herein incorporated by reference.

As can be seen, the passage in column 4 of *Schneider* merely teaches the definition of a universal resource identifier. The passage does not teach the limitation of ***receiving a search statement as a result of a user input, wherein the search statement includes a universal resource identifier and a regular expression.*** Furthermore, the passage in column 18 of *Schneider* merely teaches the steps of requesting a network resource by using resource location and/or name resolution services. The passage details how an

input is parsed to determine if it contains delimiters. If the input does contain delimiters, then a determination is made as to whether a valid IP address or domain name is present. Nowhere does this passage teach or even suggest the feature of ***receiving a search statement as a result of a user input, wherein the search statement includes a universal resource identifier and a regular expression.*** Neither of the two cited passages of *Schneider* makes any mention of ***a regular expression***. Thus, the passages cannot teach the feature of ***receiving a search statement as a result of a user input, wherein the search statement includes a universal resource identifier and a regular expression.*** Thus, *Schneider* fails to anticipate claim 1, as *Schneider* fails to teach each and every feature of claim 1, as recited in claim 1.

Additionally, *Schneider* fails to teach the feature of ***parsing the retrieved universal resource identifiers for the regular expression to form search results.*** The Office Action alleges that *Schneider* teaches this feature in column 21, lines 48-63, column 30, lines 30-42, reproduced below for the Examiner's convenience, and column 18, lines 30-55, reproduced above.

> To generate a new URI, the parsed components (as illustrated in FIG. **2**b) are concatenated with a resolvable TLD. For example a fictitious URI such as "http://united.states" is parsed, where "http" is the scheme **262**, there is no path **268** or port **274**, the hostname **282** is "united", and the HLD **280** is "states". The HLD is determined in step **310** to be a TLDA, which is then modified by recursive truncation to yield the resolvable TLD "st". The parsed components; scheme **262**, hostname **282**, and TLD can then be concatenated with the "." delimiter to generate in step **422** a new URI "http://united.st". Another example, "http://united.stores" would also yield "http://united.st". Truncation enables a correspondence between abbreviations and names or words. This method yields know-how for new and creative purchasing strategies of domain names from countries around the globe.
>
> Though a user can adjust configuration settings (as discussed in conjunction with FIGS. **7**, **8**, **9**, **10**a, **11**) in lieu of accessing a registry or translation database for URI generation through different methods of calculation/resolution, such configurations can be cumbersome adding extra steps for the user to obtain desired results. Accordingly, FIG. **14**a shows how a registry is used (in lieu of configuration settings) instead to generate a valid URI (step **426**). First, a registered resolvable TLD is retrieved in step **1410** from a matching registration record of the registered name in the registry **182** and then a valid URI is calculated and generated in step **1414** from the parsed input **210** and retrieved resolvable TLD.

The passage in column 21, lines 48-63 of *Schneider* teaches that parsed components are concatenated with a resolvable top-level domain (TLD) to form a new URI. This only occurs when the input received does not contain a valid URI, as explained in *Schneider*, column 19, line 66 through column 20, line 31, reproduced below for the Examiner's convenience.

> When input **210** includes a domain name, resolvability can be determined by parsing a HLD from the input **210**. Referring now to the prior art of FIG. **2**b, a URI **210'** including a scheme, Fully Qualified Domain Name (FQDN), port, and path is parsed. The scheme **262** is parsed in step **260** from the URI **210'** leaving the FQDN, port, and path **264**. The path **268** is parsed in step **266** from the FQDN, port, and path **264** leaving the FQDN and port **270**. The port **274** is parsed in step **272** from the FQDN and port **270** leaving the FQDN **276**. The HLD **280** is parsed in step **278** from the FQDN **276** leaving a hostname **282**. FIG. 2b illustrates one of many parsing schemes that can be applied when parsing input in step **210**.
>
> Rather than displaying an error message in step **230** in response to input **210** having a domain name determined in step **226** to be not valid (e.g., fictitious domain name), in a preferred aspect of the present invention, further steps are performed instead as shown in FIG. **3**. The HLD **280** is compared in step **310** to a list of resolvable TLDs **180** to determine HLD **280** resolvability in step **314**. If the HLD **280** is determined in step **314** to be resolvable, then a more specific browser error message **318** can be displayed stating "Domain name is not valid. Select link to learn more about proper domain name syntax". Upon display, it can further be determined in step **322** whether received input **210** is processed as a search request in step **218**. When this is the case, a search request is processed and results if any, can then be notified, accessed, and/or displayed in step **222**. When the HLD **280** is determined in step **314** to be not resolvable, then the HLD **280** is a TLDA, and the input **210** now determined to have a FDN is further processed in step **326**. After TLDA processing in step **326**, the step of URI resolvability can be determined in step **242**.

The above cited passage of ***Schneider teaches that the URI received as input as part for the search statement, is parsed.*** Then as explained in column 21, lines 48-63, these parsed components of the URI received as input for a search statement, are then concatenated to try and generate a new, valid URI.

The passage in column 30, lines 30-42 merely teaches how to use a registry in lieu of configuration settings to generate a valid URI to be used in place of the invalid URI supplied as the search input.

Thus, these two passages of *Schneider* merely teach methods for generating a valid URI to use in search when an invalid URI is supplied as a search input.

As discussed above, the passage in column 18 of *Schneider* merely teaches the steps of requesting a network resource by using resource location and/or name resolution services.

Thus, none of the passages cited by the Office Action as allegedly teaching the feature of ***parsing the retrieved universal resource identifiers for the regular expression to form search results***, actually teach the feature of ***parsing the retrieved universal resource identifiers for the regular expression to form search results***, as none of these passage teaches anything about a universal resource identifier that is

retrieved as a result of a search. Furthermore, none of the cited passages teaches a regular expression or parsing a retrieved universal resource identifier for a regular expression. Thus, *Schneider* fails to anticipate claim 1, as *Schneider* fails to teach each and every feature of claim 1, as recited in claim 1.

Therefore, for at least the reasons set forth above, Applicants submit that claim 1 is in condition for allowance over the *Schneider* reference, as the *Schneider* reference fails to teach each and every feature of claim 1. Thus, the *Schneider* reference fails to anticipate claim 1. Claim 7, 8, and 14 recite features similar to those of claim 1. Therefore, the same distinctions that distinguish claim 1 from the *Schneider* reference apply to claims 7, 8, and 14. Thus, Applicants submit that claims 7, 8, and 14 are also in condition for allowance over the *Schneider* reference.

Since claims 2-6 and 9-13 depend from claims 1 and 8, the same distinctions between *Schneider* and the claimed invention in claims 1 and 8 exist for claims 2-6 and 9-13. Therefore, Applicants submit that claims 2-6 and 9-13 are also in condition for allowance, at least by their virtue of depending from an allowable claim. Additionally, claims 5 and 12 claim other additional combinations of features not suggested by the reference. Consequently, it is respectfully urged that the rejection of claims 1-14 have been overcome.

Claims 5 and 12 recite the feature of ***searching a table of contents for a match to the regular expression, wherein the table of contents contains the retrieved universal resource identifiers***. The Office Action alleges that *Schneider* in Figure 13, which the Office Action admits is a table of generated URIs, teaches this feature. (See Office Action mailed March 9, 2007, p. 7) As was discussed above in regards to claim 1, *Schneider* teaches generating URIs based on the parsed components of an invalid URI that was supplied as a search input. Thus, the URIs contained in Figure 13 are not ***retrieved universal resource identifiers***, as recited in claims 5 and 12. Further, nothing in Figure 13, or in the text of *Schneider* that describes Figure 13, teaches, suggests, or even hints at searching the URIs for a match to a regular expression. Thus, *Schneider* fails to anticipate claims 5 and 12, as *Schneider* fails to teach each and every feature of claims 5 and 12, as recited in claims 5 and 12.

Therefore, the rejection of claims 1-14 under 35 U.S.C. § 102 has been overcome. Thus, the Applicants respectfully request that the rejection of claims 1-14 under 35 U.S.C. § 102 be withdrawn.

Additionally, *Schneider* does not anticipate new claim 15. New claim 15 recites:

> 15. A method in a data processing system for searching for Web pages within a Web site, the method comprising:
>
> receiving a search statement from a user at a client browser, wherein the search statement includes a universal resource identifier and a regular expression;
>
> in response to receiving the search statement at the client browser, sending a request, by the client browser, to a server to retrieve a table of contents, wherein the table of contents comprises universal resource identifiers associated with the universal resource identifier in the request;

receiving the table of contents from the server;

parsing the universal resource identifiers in the received table of contents for the regular expression, by the client browser, to form search results; and

displaying the search results to the user, wherein the search results include a list of universal resource identifiers associated with the Web pages within the Web site.

Schneider does not teach the features of new claim 15. Claim 15 recites features similar to those of claim 1. Therefore, the distinctions that distinguish claim 1 from the *Schneider* reference also apply to claim 15. However, claim 15 recites additional features not taught or suggested by *Schneider*. In claim 15, the steps of receiving a search request, sending a request for a table of contents, parsing the universal resource identifiers in the received table of contents, and forming and displaying the search results are all performed by the client browser. *Schneider* teaches a process wherein every step is performed at the server.

IV. Conclusion

It is respectfully urged that the subject application is patentable over *Schneider* and is now in condition for allowance.

The Examiner is invited to call the undersigned at the below-listed telephone number if in the opinion of the Examiner such a telephone conference would expedite or aid the prosecution and examination of this application.

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Respectfully submitted,

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